



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,499	08/14/2001	Christian D. Garcia	68.0194 CON	9552

7590 01/20/2004

SCHLUMBERBER TECHNOLOGY CORPORATION
14910 Airline Road
P.O. Box 1590
Rosharon, TX 77583-1590

EXAMINER

HALFORD, BRIAN D

ART UNIT	PAPER NUMBER
----------	--------------

3672

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,499

Applicant(s)

GARCIA ET AL.

Examiner

Brian D Halford

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 20.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-12, 16-19 and 21-51 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 13, 14, 15 and 20 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing. Specifically, the Examiner requires a drawing figure to provide clarification of the "upwardly facing valve seat", which is designated by reference numeral 36. The interplay between the valve seat (36) and the flapper valve (30) is unclear.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 2, 5 and 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 09/754,464 in view of French. The claim language present in

Art Unit: 3672

claims 1, 2, 5 and 6 of the instant application is substantially identical to the claim language presented in claims 1-6 of copending Application No. 09/754,464 with the exception of an "upwardly facing valve seat" recitation in lines 7-8 of the instant application. However, an upwardly facing valve seat is notoriously conventional within the wellbore art. As such, the patent to French discloses a valve assembly for use in downhole applications. French depicts a sliding sleeve assembly (16) in Figures 1 and 2. Control fluid permits the opening and closing of flapper valve (18). As shown in Figure 2 and discussed in lines 45-64 of column 5, in the closed position the lower surface (70) of the flapper valve (18) rests upon the seals *or* upwardly facing valve seat (40) to effect a seal. Therefore it would have been considered obvious to a person having ordinary skill in the art, at the time the invention was made, to provide the instant invention with the seals *or* upwardly facing valve seat (40) of French to maintain a seal.

This is a provisional obviousness-type double patenting rejection.

4. Claim 13 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 24 of copending Application No. 09/754,464 in view of French. The claim language present in claim 13 of the instant application is substantially identical to the claim language presented in claims 1 and 24 of copending Application No. 09/754,464 with the exception of an "upwardly facing valve seat" recitation in lines 7-8 of the instant application. However, an upwardly facing valve seat is notoriously conventional within the wellbore art. As such, the patent to French discloses a valve assembly for use in downhole applications. French depicts a sliding sleeve assembly (16) in Figures 1 and

Art Unit: 3672

2. Control fluid permits the opening and closing of flapper valve (18). As shown in Figure 2 and discussed in lines 45-64 of column 5, in the closed position the lower surface (70) of the flapper valve (18) rests upon the seals *or* upwardly facing valve seat (40) to effect a seal. Therefore it would have been considered obvious to a person having ordinary skill in the art, at the time the invention was made, to provide the instant invention with the seals *or* upwardly facing valve seat (40) of French to maintain a seal.

This is a provisional obviousness-type double patenting rejection.

5. Claim 14 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-27 of copending Application No. 09/754,464. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter in claims 25-27 of copending Application No. 09/754,464, when taken as a whole, is identical to the claimed subject matter in claim 14 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 15 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29 and 30 of copending Application No. 09/754,464. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter in claims 29 and 30 of copending Application No. 09/754,464, when taken as a whole, is identical to the claimed subject matter in claim 15 of the instant application.

Art Unit: 3672

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claim 20 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39-41 of copending Application No. 09/754,464. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter in claims 39-41 of copending Application No. 09/754,464, when taken as a whole, is identical to the claimed subject matter in claim 20 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

8. Applicant's arguments with respect to claims 1-6, 8, 9, 11-14, 16-19, 40-43 and 46 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

9. Claims 7-12, 16-19 and 21-51 are allowed.

10. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3672

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Patel, Rawson *et al.* and Pringle *et al.* disclose the employment of upwardly facing valve seats.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Halford whose telephone number is (703) 306-0556. The examiner can normally be reached on M-F 10:30-8:00; alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

bdh

bdh

January 7, 2004